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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/291,294	04/14/1999	CRIS T. PALTENGHE	CITI0131-US	1910

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KILPATRICK STOCKTON LLP  
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WASHINGTON, DC 20005

EXAMINER

NORMAN, MARC E

ART UNIT	PAPER NUMBER
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3744

DATE MAILED: 07/03/2003

89

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/291,294

Applicant(s)

PALTENGHE ET AL.

Examiner

Marc E. Norman

Art Unit

3744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 April 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-12,14,19,20,22-24,28-32,34,38-41,48-50,72,73,75-81,84,85 and 93 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Continuation of Disposition of Claims: Claims pending in the application are 1,3-5,7-12,14,19,20,22-24,28-32,34,38-41,48-50,72,73,75-81,84,85 and 93.

## **DETAILED ACTION**

### **Response to Amendment/Arguments**

In the previous Office Action (paper #16), the Examiner indicated new claim 93 as reciting allowable subject matter. In particular, the Office Action stated that the applied art failed to teach the limitations regarding the "remote aspect being periodically updated with data stored on the local aspect by a virtual archivist function of the virtual wallet application via the network." Applicant has subsequently amended claims 1, 32, 41, and 81 to also recite these limitations. However, newly found art has been found which shows that this aspect of the invention would indeed have been obvious to one of ordinary skill in the art at the time the invention was made, and that the Examiner's indication of allowable subject matter was incorrect. Accordingly, a new Office Action, which takes into account this newly found art, is set forth below. Since the new rejections were not necessitated by Applicant's amendments, the present Office Action is made Non-Final. The Examiner apologizes that these issues were not raised in the previous Office Action.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3744

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3-5, 7-12, 14, 19, 20, 22-24, 28-32, 34, 38-41, 48-50, 72, 73, 75-81, 84, 85, and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer, Rosen, Public Legal Education of Nova Scotia, and Shannon.

As per claims 1, 3-5, 7-12, 14, 19, 20, 22-24, 28-32, 34, 38-41, 48-50, 72, 73, 75-81, 84, and 85, these claims are unchanged except for the addition of the limitation of a local aspect residing on the terminal of an owner, a remote aspect on a server coupled to the terminal via a network, and periodically updating the remote aspect with the data stored on the local aspect via the network (added to independent claims 1, 32, 41, and 81). All of the features of these claims except these newly added limitations are taught by the combination of Fischer, Rosen, and Public Legal Education of Nova Scotia, as set forth in the previous Office Actions (see papers 9, 12, and 16). Shannon teaches a data archiving system comprising a local aspect on the terminal 52 of an owner, a remote aspect on a server 56 coupled to the terminal via a network 54, and periodically updating the remote aspect with the data stored on the local aspect via the network (Abstract, lines 8-12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine this arrangement of Shannon to the combined system of Fischer, Rosen, and Public Legal Education of Nova Scotia for the purpose of allowing the owner to

Art Unit: 3744

periodically update pertinent information to the backup/archive server. In an escrow system, it is clearly obvious that the stored information would need to be updated from time to time (just as it would be obvious to update escrowed information in a safety deposit box). Performing the periodic updating of the remotely stored data in the manner as taught by Shannon would clearly have been obvious to one of ordinary skill at the time of the invention for the purpose of taking advantage of the well-known efficiencies of computer-server network data transfer/storing systems.

As per claim 93, this claim is also rejected based on the reasoning set forth above and on the discussions of Fischer, Rosen, and Public Legal Education of Nova Scotia as set forth in the previous Office Actions. Again, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply this arrangement of Shannon to the combined system of Fischer, Rosen, and Public Legal Education of Nova Scotia for the purpose of allowing the owner to periodically update pertinent information to the backup/archive server.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc E. Norman whose telephone number is 703-305-2711. The examiner can normally be reached on Mon.-Fri., 8:00-5:30, with first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Denise Esquivel can be reached on 703-308-2597. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Art Unit: 3744

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5648.

MN

June 27, 2003

A handwritten signature in black ink, appearing to read 'Marc Norman', with a stylized flourish at the end.

**MARC NORMAN  
PATENT EXAMINER**